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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/552,863

10/11/2005

Beat Romeo Rigert

UF-P236USw

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06/26/2008

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EXAMINER

NGUYEN, PHU HOANG

ART UNIT

PAPER NUMBER

1791

MAIL DATE

DELIVERY MODE

06/26/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/552,863	Applicant(s) RIGERT, BEAT ROMEO	
	Examiner PHU H. NGUYEN	Art Unit 1791	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 March 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 5-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 5-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Acknowledgement is made of Amendment received 3/3/2008. Claims 5-10 are currently amended. Claims 11-16 are newly added.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5, 8 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baker (U.S Patent No. 3651817) in view of Trikilis (U.S Patent No. 4989368).

Regarding claim 5, Baker discloses a portable container (12, fig. 1) for extinguishing and for temporary storing stubs, the container comprising:

a drum (around reference sign 18, fig. 5) rotatable on an axis, the drum having at least one recess (56, fig. 5) running parallel to said axis for temporary accepting a cigarette stub.

a chamber (space containing reference sign 38, fig. 5) closed to surroundings for storing extinguished cigarette stubs.

an opening (space showing reference sign 16, fig. 1) that is arranged opposite to a front face of the drum and that in specific rotating positions of the drum aligns with said at least one recess of the drum.

a lid (14, fig. 5) connected to the drum, the lid having at least one opening for the insertion of cigarette stub, whereby the lid either uncover or covers said opening of the container.

Baker does not expressly disclose the drum divided into drum parts and a plurality of elements arranged on a side wall of the container. Trikilis discloses a revolving door (corresponding to the claimed "drum") includes pivot column (corresponding to the claimed "axis") having a plurality of integrally formed first grooves extending longitudinally there along at equidistantly spaced intervals (corresponding to the claimed "gaps running orthogonally to said axis") there around. Providing a plurality of barrier members (drum parts) and locking bars (corresponding to the claimed "a plurality of elements") extending from side wall that fit into the gaps and change the cross section of the recess (space between the reference sign 3 and 3) (Abstract and figure 1). This construction is provided to facilitate selective passage between two separated areas (column 2, lines 45-47). Therefore, it would have been obvious to modify they portable container as taught by Trikilis to facilitate selective passage between two separated areas that preventing the stub from clogging up the containing by re-entering the space where it was first entered the portable container.

Furthermore, Baker discloses the orientation of the front face of the drum can run substantially parallel to the axis of rotation of the drum. However, Trikilis discloses vertically rotation of the revolving door shows another possible orientation for the drum. Therefore, it would have been obvious to one of ordinary skill in the art a the time the invention was made to construct the front face of the drum running either substantially

orthogonally (vertically as taught by Trikilis) or parallel (horizontally as taught by Baker) to the rotation axis of the drum.

Regarding claims 8 and 10, Trikkilis discloses the number of parts amounts to at least four.

Claims 6 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baker (U.S Patent No. 3651817) and Trikilis (U.S Patent No. 4989368) as applied to claim 5 above and further in view of Manion (U.S Patent No. 2661747). The combination of Baker and Trikilis does not expressly disclose the chamber has a bent inner floor.

Regarding claim 6, Manion discloses a portable container with chamber (11, fig. 2) that has a bent inner floor rising towards the side wall of the container. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make a bent floor for the chamber at least as a design choice.

Regarding claim 9, Trikkilis discloses the number of parts amounts to at least four.

Regarding claims 11-12 and 14-16, from the top view along the axis of rotation the references discloses the elements having roughly the shape of a triangle (see fig 2 of Manion, fig. 1 of Trikilis and fig. 3 of Baker).

Claims 7 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baker (U.S Patent No. 3651817) and Trikilis (U.S Patent No. 4989368) as applied to claim 5 above and further in view of Snadden (U.S Patent No. 1912598).

Regarding claim 7, Snadden discloses an end of at least one recess located opposite said front face of the drum is terminated by a floor area (below reference sign 19, fig. 5).

Regarding claim 13, from the top view along the axis of rotation the references discloses the elements having roughly the shape of a triangle (see fig 2 of Manion, fig. 1 of Trikilis and fig. 3 of Baker).

Response to Arguments

Applicant's arguments filed 3/3/2008 have been fully considered but they are not persuasive.

In response to applicant's argument that Trikilis (U.S Patent No. 4989368) is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Trikilis is reasonably pertinent to the problem of facilitate selective passage between two separated areas.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a

reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Applicant argues that the amended claim 5 reflects the drum orientation difference between the present invention (positioned vertically) and that of the Baker reference (positioned horizontally). However Baker discloses the orientation of the front face of the drum can run substantially parallel to the axis of rotation of the drum. However, Trikilis discloses vertically rotation of the revolving door shows another possible orientation for the drum. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to construct the front face of the drum running either substantially orthogonally (vertically as taught by Trikilis) or parallel (horizontally as taught by Baker) to the rotation axis of the drum.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the bending of the inner floor has been made in order to achieve that the cigarette stub is also moved in the direction of the rotation axis of the drum. This movement supports the releasing of the cigarette stub from the body and ensures that even a cigarette stub sticking or adhering to the body is removed without problem) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to PHU H. NGUYEN whose telephone number is (571)272-5931. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Phillip Tucker can be reached on 571-272-1095. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

P.N 6/21/2008

/Philip C Tucker/
Supervisory Patent Examiner, Art Unit 1791